

Application No.: 10/039654Case No.: 53750US002**REMARKS****35 U.S.C. § 103 Rejections**

Claims 1-7, 9, 10 and 15-20 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over Clark et al. (U.S. Patent 5,853,846) in view of Szekely (U.S. Patent 5,775,835).

Claim 1 recites, "A method of making a magnetic pavement marker comprising the steps of forming an array of magnetic pavement elements interconnected by a carrier web; and forming a frangible connection between each magnetic pavement element and the carrier web by at least partially severing the carrier web around a perimeter of each magnetic pavement element."

Claim 15 recites the feature "wherein the carrier web is at least partially severed around the perimeter of each magnetic pavement element."

The Applicant submits that neither Clark et al., nor Szekely teach this claim limitation. Accordingly, the combination of references fails to teach all the claim limitations.

The Applicant previously argued that the Examiner failed to make a prima facie case of obviousness because the references themselves fail to provide any teaching or suggestion to make the claimed combination.

In response to Applicant's argument, the Examiner stated that, "In this case Szekely clearly teaches cutting the marker in order to fit a particular area. Both Clark et al. and Szekely are concerned with pavement marking; therefore, it would have been within ordinary skill to consider the teaching of Szekely while working with the apparatus of Clark et al."

First of all, if the connections between the magnetic elements of Clark et al. are (inherently) frangible as alleged by the Examiner, than the pavement marking article of Clark et al. could easily be broken off once the end of a roadway was reached. Accordingly, there would be no reason to at least partially sever the carrier web around a perimeter of each magnetic pavement element as presently claimed.

Secondly, the mere fact that both Clark et al. and Szekely are concerned with pavement markings is not sufficient motivation. The Applicant would like to bring to the Examiner's

Application No.: 10/039654Case No.: 53750US002

attention the attached Decision on Appeal regarding Appeal No. 1999-2549 regarding patent application No. 08/955,579 subsequently issued as U.S. Patent No. 6,468,678.

Thirdly, the criteria is not whether "it would have been within ordinary skill" as most inventions are within ordinary skill. Rather, the criteria is whether the references themselves, i.e. Clark et al. and/or Szeckely provide any teaching or suggestion, i.e. any reason, to make the claimed combination. The Applicant submits that the references lack such teaching

The Applicant submits that the Examiner has failed to make a prime facie case of obviousness. Reconsideration and a timely allowance are respectfully requested.

Respectfully submitted,

11-19-04  
Date

By: Carolyn A. Fischer  
Carolyn A. Fischer, Reg. No.: 39,091  
Telephone No.: (651) 575-3915

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833